R E M A R K S

Presently claims 1-3 and 5-22 are pending in the application. Reconsideration and allowance of all pending claims are requested in view of the remarks below.

Claim Rejections under 35 U.S.C. §103

Claims 1-3, 5, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones III et al., U.S. Pat. No. 6,925,441 in view of Katz et al., U.S. Pat. No. 6,055,513. Applicant traverses this rejection.

The Office Action, in paragraph 9, admits that Jones does not teach a second data set provided by one or more demographic databases. Therefore, Jones is unable to teach or suggest "a rule processor receiving said first data set and said second data set and applying said first and second data sets to one or more rules to determine a score predicting behavior relating to said collected information identifying said user," as recited in claim 1. The newly cited Jones reference is no better than the previously cited Kaminsky, Lazarus, Katz or other references applied and overcome.

As argued persuasively by Applicant in response to the previous Office Action, Katz (as well as Jones, Kaminsky, Lazarus, etc.) also fails to disclose or suggest a first and second database such as applicant particularly discloses and claims. Further, Katz (or any of the other cited references) does not disclose or suggest applying first and second data sets to rules as claimed in the instant application. In contrast, Katz is specifically directed towards a telemarketing system adapted for the selection and upsell of products to a customer based upon the primary transaction data and other information. The Examiner cites col. 8, line 63 to col. 9, line 2; and col. 9, line 65 to col. 10, line 19 of Katz in rejecting Applicant's claims. This portion of Katz merely states that:

"the system includes primary transaction data and at least a second data element obtained from a database, especially a remote, third party database or databases. Primary transaction data may include data relating to or reflecting the initial or

2

primary contact from the customer to the system...A demographic database may be utilized to identify direct or predicted attributes of the customer...the third party database may provide responsive, effective information for the upsell determination... [see Fig. 2 and also col. 18, line 40-col. 19, line 15; col. 23, lines 6-19] "

Applicant respectfully submits that the above-quoted portion of Katz does not teach or suggest, "a processor ... receiving said first data set from the one or more subscriber servers and said second data set from the one or more demographic databases, said processor including a rule processor receiving said first data set and said second data set and applying said first and second data sets to one or more rules to determine a score predicting behavior relating to said collected information identifying said user," as particularly claimed by Applicant. Again, there is no mention whatsoever of receiving a first data set from one or more subscriber servers and a second data set from one or more demographic databases. There is no mention or suggestion in Katz, or any of the other cited references, of <u>determining a score via a rule processor applying rules to a first and second data set.</u>

Specifically, Applicant applies rules via a rule processor to two distinct data sets, i.e., "a first data set of user information" and a "second data set of said third party information relating to targeted market segments." Since each and every element of independent claim 1 is not present as in the claims, Applicant respectfully submits that claim 1 is patentable over Jones in view of Katz under 35 U.S.C. 103(a). Similarly, neither Jones nor Katz teach or suggest "applying said first and second data sets to one or more rules to determine a score predicting behavior," as recited in claim 14.

Furthermore, even if the combination of Jones and Katz had all the elements of claim 1 or 14, Applicant disputes the Office Action's assertion that it would have been obvious to modify Jones in view of Katz, as the art itself does not suggest such a modification or combination. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Paragraph 10 of the Office Action, appears to cite Katz (col. 10. lines 15-19) for the motivation to combine being related to increasing efficiency of Jones' system. However,

the alleged increase in efficiency of Jones' system as modified by Katz is not disclosed in the references. Furthermore, the cited portion of Katz does not involve efficiency at all, but appears to discuss security/disclosure concerns. Interestingly, paragraph 16 of the Office Action does not discuss efficiency as a motivation to combine, but instead asserts the prevention of confidential information access by an identity thief as a benefit of the combination of Jones and Katz. However, as discussed above, there is no discussion in the references, or assertion in the Office Action, that the references themselves teach or suggest the combination. For example, neither of the references even use the term "identity thief." The Examiner's reasoning for holding obvious the claimed invention in view of the prior art appears to be based, not on knowledge generally available from the prior art but, rather, on the Applicant's own disclosure of problems existing in prior art devices and the Applicant's solution thereof.

In view of the above, the rejections of independent claims 1 and 14, and claims 2-3, 5, 8 and 13 ultimately depending therefrom are improper and should be withdrawn.

Claims 6-7 and 17-20 are rejected under 35 U.S.C.§ 103(a) as being unpatentable over Jones and Katz in view of Lazarus et al., U.S. Patent No. 6,134,532. Applicant traverses this rejection.

As previously set forth in Applicant's Responses dated Februarys 23, 2005 and July 20, 2005, Lazarus is directed towards a system for selecting advertisements in a computer environment. The system includes a database of electronic advertisements. Observed behavior of a user computer in the computer environment is converted to a "behavior vector." The behavior vector is compared to a group of "entity vectors" indicative of the ads, and entity vectors closely associated with the observed behavior are identified. A selector accesses the database with the identified entity vector to select electronic ads to communicate to the user computer. Applicant respectfully submits that Lazarus does not teach or suggest, "a processor ... receiving said first data set from the one or more subscriber servers and said second data set from the one as more demographic databases, said processor including a rule processor receiving said first data set and said second data set and applying said first and second data sets to one or more rules to determine a score predicting behavior relating to said collected information identifying said user," as particularly claimed by Applicant.

4

Again, there is no mention or suggestion in Lazarus of determining a score via a rule processor applying rules to a first and second data set. Specifically, Applicant applies rules via a rule processor to two distinct data sets, i.e., "a first data set of user information" and a "second data set of said third party information relating to targeted market segments." Lazarus in fact teaches away from applying rules which "requires extensive knowledge about the targeted operating domain" (lines 21-22 of col. 3). Indeed, Lazarus states unequivocally that its system for selecting ads "does not require any rules for operation [but is instead based on] neural network techniques" (lines 53-55 of col. 5, emphasis added).

Applicant respectfully submits that claims 6-7 and 17-20 depend ultimately from one of claims 1 and 14 and are therefore distinguishable from Lazarus for at least the reasons set forth hereinbefore with respect to claims 1 and 14. Furthermore, the Examiner does not cite Lazarus to make up for the above-described deficiencies of Jones and Katz, but instead cites Lazarus only in regard to features in dependent claims 6-7 and 17-20. Accordingly, Applicant submits that claims 6-7 and 17-20 are distinguishable from the applied combination of Jones, Katz and Lazarus for reasons set forth hereinbefore with respect to claims 1 and 14, and that the rejection of claims 6-7 and 17-20 is therefore improper and should be withdrawn.

Claims 15-16 are rejected under 35 U.S.C.§ 103(a) as being unpatentable over Jones and Katz in view of Gerace, U.S. Pat. No. 5,848,396. Applicant traverses this rejection.

As discussed in Applicant's previous reply of July 20, 2005, Gerace is directed toward software for targeting end users based on so-called psychographic profiles formed by recording the users' computer activity. Categories of interest and display format in each category are revealed by the profile, based on user viewing of so-called "agate information." Using the profile, advertisements are displayed to appropriately selected users. Gerace does not disclose or suggest applying rules to a first and second data set to determine a score. As such, Gerace does not overcome the deficiencies of Jones and Katz discussed above in relation to claims 1 and 14. Therefore, the rejection of claims 15 and 16, depending from claim 14, should be withdrawn.

Claims 9-13 and 21-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jones and Katz in view of the "Official Notice". Applicant traverses this rejection.

As a preliminary matter, Applicant asserts that claims 9-13 and 21-22 are patentable at least by way of their dependencies from claim 1 or 14, discussed above. Applicant notes that the assertions of Official Notice do not overcome the deficiencies noted above regarding Jones and Katz with respect to claims 1 and 14.

With respect to the taking of Official Notice as to the type of unique keys and third party information, Applicant respectfully requests that the claim be allowed in view of the deficiencies of Jones and Katz or that the Examiner locate references addressing each of the elements of the claims. An Examiner may not rely on Official or Judicial Notice at a point where patentable novelty is argued, but must come forward with pertinent prior art. *Ex parte Cady*, 148 USPQ 162 (Bd. App. 1965).

As to claim 13 and the use of the Internet, Applicant notes that the taking of Official Notice does not overcome the deficiencies of Jones and Katz.
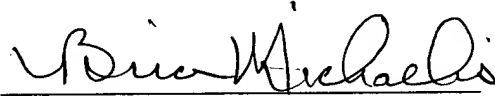
Regarding paragraph 37 of the Office Action, Applicant notes with appreciation the statement that the arguments with respect to claims 1-3 and 5-22 filed July 22, 2005 have been fully considered and are persuasive. As noted throughout herein, many of these same persuasive arguments continue to apply to the rejections in the present Office Action.

Conclusion

In view of the remarks set forth above, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If the Examiner feels that a further telephone conference would expedite allowance/issuance of this case, or resolve any remaining issues, the Examiner is invited to contact the undersigned at (617) 856-8382.

Respectfully submitted,

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7